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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,335	10/04/2000	Keith Henning	COREMET-002	6561

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EXAMINER	
DURAN, ARTHUR D	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/679,335	HENNING ET AL.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 October 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. Claims 1-17 have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-5, 12-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts. Appropriate correction is required.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The

phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in

affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the current application, no technological art (i.e., computer, network, server) is being utilized by claims 1-5, 12-15. Appropriate correction is required.

Independent claims 1 and 12 disclose data being stored on a server. However, these claims do not disclose the server being utilized for the method steps of the claim. The server must be utilized in order to meet 35 USC 101 requirements. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claim 1-3, 6, 12-15, 20 are rejected under 35 U.S.C. 102(e) as being unpatentable over Gardenswartz (6,055,573).

Claim 1: Gardenswartz discloses a method for accumulating consumer sales transaction data from a plurality of sales transaction sources for further use in targeted advertising, the method comprising the steps of:

standardizing the consumer sales transaction data such that the consumer sales transaction data conforms to a predetermined format (Fig. 2a; Fig. 2b);

storing the standardized consumer sales transaction data on a server comprising memory (Fig. 1; item 8);

accumulating the standardized consumer sales transaction data for each consumer such that a group of the consumer sales transaction data relating to a specific consumer is assigned to that consumer (Fig. 2a); and

segmenting the standardized consumer sales transaction data such that a group of consumers can be defined by the group's characteristics (Fig 4a; Fig. 9; Fig. 8; col 12, lines 37-48).

Claim 2: Gardenswartz discloses the method of claim 1 and further discloses the step of cross referencing the standardized consumer sales transaction data with consumer sales transaction data accumulated from the plurality of sales transaction sources (col 5, line 65-col 6, line 15).

Claim 3: Gardenswartz discloses the method of claim 1 wherein the step of standardizing includes grouping the consumer sales transaction data into a plurality of data fields that are separated by delimiters (Fig. 2a; Fig. 2b; col 8, lines 3-10).

Claim 6: Gardenswartz discloses a system for the accumulation and segmentation of consumer sales transaction data, the system comprising:

a plurality of transaction servers for storing consumer sales transaction data from consumer sales transactions (Fig. 1; col 5, lines 60-65); and

a main database server, comprising memory, coupled to the plurality of transaction servers and to the Internet, the main database server additionally comprising an apparatus, coupled to each transaction server, for downloading the consumer sales transaction data from the plurality of transaction servers (Fig. 1; col 5, lines 30-43; col 6, lines 1-15).

Claim 12: Gardenswartz discloses a method for the accumulation of consumer sales transaction data, the system comprising a plurality of consumer transaction servers and a main database server having memory, the method comprising the steps of:

standardizing the consumer sales transaction data into a predetermined format, thus generating standardized sales data; storing the standardized sales data in the main database server memory; and

accumulating the standardized sales data for each consumer such that a group of the standardized sales data relating to a specific consumer and gathered from at least one of the plurality of consumer transaction servers is assigned to that consumer in the form of a consumer data file (Fig. 1; Fig. 2a; Fig. 2b; Fig. 4a; Fig. 9; col 5, lines 30-43; col 6, lines 1-15; col 5, lines 60-65).

Claim 13, 14: Gardenswartz discloses the method of claim 12 wherein the main database server memory comprises a hard drive, a tape drive (col 6, lines 5-15; col 21, lines 20-23).

Claim 15: Gardenswartz discloses the method of claim 12 and further including the step of segmenting the standardized sales data for each consumer such that a group of consumers can be defined by the group's characteristics (Fig 4a; Fig. 9; Fig. 8; col 12, lines 37-48).

Claim 20: Gardenswartz discloses the method of claim 12 wherein the main database server memory comprises a CD-ROM drive (col 6, lines 5-15; col 21, lines 20-23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4, 5, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz (6,055,573) in view of Lech (5,258,855).

Claim 4, 5, 16, 17: Gardenswartz discloses the method of claim 3, and further discloses that the data fields comprise a field for the consumer's mailing address, a field for the consumer's item of purchase, and a field for the consumer's cost of purchase, and date of purchase (Fig. 2b; col 11, lines 43-50).

Gardenswartz does not explicitly disclose a field for a consumer's age.

However, Gardenswartz discloses storing user demographic information that will assist in targeting (col 11, lines 43-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add age as user demographic information to Gardenswartz's user information. One would have been motivated to do this in order to provide further data on a user that is useful in targeting.

Gardenswartz further discloses a wide variety of tabular and database means for storing information (col 8, lines 3-10; Fig. 2a; Fig. 2b).

Gardenswartz does not explicitly disclose the utilization of a semicolon.

However, Lech discloses that the semicolon can be utilized as a data delimiter (col 11, lines 50-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the Lech's semicolon is an obvious character that Gardenswartz can utilize as a delimiter for the data. One would have been motivated to do this in order to separate data of different types.

5. Claims 7-11, 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz (6,055,573) in view of Wilson (5,864,827).

Claim 7-11, 18, 19: Gardenswartz discloses the method of claim 7, 12.

Gardenswartz futher discloses the uilization of a WAN or the Internet (col 5, lines 37-42) and a network with servers and real-time communication (Fig. 1; col 6, lines 2-5).

Gardenswartz does not explicitly disclose the utilization of satellite, modem, telephone line with the Internet.

However, Wilson discloses the Internet and utilizing a telephone line, satellite, modem, dedicated line for networked communication (col 4, lines 8-19)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Wilson's variety of networked communications utilizing the Internet or a WAN to Gardenswartz's networked communication utilizing the Internet or a

WAN. One would have been motivated to do this in order to provide Gardenswartz with appropriate options for network communications.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Ono (5,909,023) discloses transferring user transaction data to a central server;

b) Gardenswartz (6,298,330) discloses transferring user transaction data to a central server.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AD

1/15/04

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